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IN THE

Supreme Court of the United States

OCTOBER TERM, 1956

No. 444

TATKO BROTHERS SLATE CO., INC.,
Petitioner,

v.

VERMONT STRUCTURAL SLATE CO., INC.,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

W. BROWN MORTON, JR.,
247 Park Avenue,
New York 17, N. Y.,
Attorney for Petitioner.

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

Petitioner, Tatko Brothers Slate Co., Inc., prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Second Circuit entered on May 8, 1956 in the case there entitled "Vermont Structural Slate Co., Inc., Plaintiff-Appellee, v. Tatko Brothers Slate Co., Inc., Defendant-Appellant, Docket 23886."

Opinions Below

The opinion and judgment of the District Court are printed in the certified record and the nine copies of the printed record below filed herewith (R. 91a-96a)* and is

* Record citations will be in the following form:

(R. 2a)—page 2a of the certified record and of the printed record below which have corresponding pagination;

(A. 2a)—page 2a of the Appendix to this petition bound with it.

reported at 134 F. Supp. 4. The opinion and judgment of the Court of Appeals are printed in the Appendix hereto (A. 1a-3a) and reported at 233 F. 2d 9.

Jurisdiction

The judgment of the Court of Appeals was entered on May 8, 1956 (R. 102a). A timely petition for rehearing was denied on June 26, 1956 (R. 111a). The jurisdiction of this Court is invoked under 28 U. S. C. § 1254(1).

The Question Presented

The issue of whether certain unquestioned differences between a patented structure and the prior art were "obvious"* was raised below by motion for summary judgment: Can the motion judge properly resolve the controverted issue upon his personal conclusion that the mere simplicity of the claimed advance establishes its unpatentability and ignore historical facts established by unchallenged affidavits, namely, that there had long been a materials-handling problem in the slate industry, widely recognized and unsolved, and that the patented structure, solving the problem by virtue of its differences from the prior art, had been immediately adopted by that industry?

Statutes Involved

Federal Rules of Civil Procedure:

"Rule 56. Summary Judgment

* * *

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* Within the meaning of 35 U. S. C. § 103 reproduced at page 4, *infra*.

"(c) Motion and Proceedings Thereon.

The motion shall be served at least 10 days before the time fixed for the hearing. The adverse party prior to the day of hearing may serve opposing affidavits. The judgment sought shall be rendered forthwith if the pleadings, depositions, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. * * *."

The Patent Act of 1952 (Title 35, United States Code):

"§ 101. Inventions Patentable

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

"§ 102. Conditions for patentability; novelty and loss of right to patent.

"A person shall be entitled to a patent unless—

"(a) The invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

"(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

"(c) he has abandoned the invention, or

"(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country or an application filed

more than twelve months before the filing of the application in the United States, or

"(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

"(f) he did not himself invent the subject matter sought to be patented, or

"(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

"§ 103. Conditions for patentability; non-obvious subject matter.

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

Statement of the Case

Sometime before March, 1954 a Mr. John Tatko devised an improved pallet for the mechanical handling and storage of slate slabs. On March 3, 1954 he filed Application Serial No. 413,941 for a patent therefor. On November

9, 1954, petitioner, as the inventor's assignee, was granted Patent No. 2,693,926 here in controversy (R. 35a-37a).

A pallet is a platform, of wood or other material, designed to permit goods placed thereon to be raised and lowered and transported from place to place and from time to time by a fork lift truck. A prior art form of pallet and the way in which pallets are handled by such trucks is shown in Figures 1 and 2 of the Cruickshank patent of September 29, 1952 (R. 38a). As shown in Figure 1, the pallets A with their superimposed loads B are handled by means of lifting trucks C having vertically movable lifting fingers (or forks) which are inserted into openings between the upper and lower faces of the sides of the pallets. As shown in Figure 2, such pallets may be made up of common boards of appropriate number and size fastened together by common nails or screws or bolts.

The Tatko pallet and the way in which its special construction accommodates slate slabs are shown in the Figures of the Tatko patent in suit (R. 35a). As shown in Figure 1, the pallet is adapted to carry slate slabs *on edge* held vertical between slabs inserted into special pockets provided in its upper deck. As shown in Figure 2, the Tatko pallets may, like the prior pallets, be made up of common boards of appropriate number and size fastened together by common nails or screws or bolts.

Those features of the Tatko pallet which distinguish it from the prior art and account for its greater utility in the slate industry are accurately and simply recited in the claims of the patent, for example, in Claim 3 (R. 37a):

> "In a pallet, the combination of a pair of stringers at each opposite end of the pallet and with the stringers of each pair spaced apart transversely forming pockets therebetween and with each of said stringers extending throughout the width of the pallet, boards secured on opposite sides of the stringers

connecting the pairs of stringers together and also the stringers of each pair, said boards at the opposite ends of the pockets closing said ends of the pockets, additional boards at the top of the pallet extending only between the inner stringers of the respective pairs and intermediate the first-mentioned boards, and boards secured to the bottoms of the stringers intermediate the first-mentioned boards substantially closing the bottoms of the pockets."

As soon as use of the Tatko pallet by petitioner became known in the industry, it was in great demand (see Affidavits R. 51a-70a) and was copied by respondent, who, when warned against unlicensed infringement (R. 13a), brought the instant action for declaratory judgment and, after issue was joined, brought a motion for summary judgment (R. 31a) that the Tatko patent was invalid for lack of invention. The motion was supported by prior art patents of the exact sort that had been considered by the Patent Office. Petitioner opposed the motion offering affidavits to show that, in fact, simple as was the realized Tatko innovation, the means and the recognized need for realizing it had long been at hand in the slate industry, but it had never been realized prior to Tatko. Respondent did not challenge these affidavits.

The District Court did not understand the nature of "invention" as a requirement for patentability and granted the motion for summary judgment thereby effectively deciding a pure fact issue adversely to petitioner without trial. The sitting panel of the Court of Appeals affirmed, perpetuating the same error of law and still denying to petitioner its right to a full trial of the same fact issue.

The error of law was in ruling that the presence of "invention" in the creation of an admittedly new and useful thing can be determined as a matter of law by

judicial comparison of the thing invented with the things of the prior art (that is, "analytically"), while instead the law requires that such a determination be made as a matter of fact by weighing the available evidence as to whether the creation of the new thing would have been obvious to the average skilled worker in the actual art involved under the circumstances of that art at the time when it was created (that is, "historically"). The fact issue that was decided without trial is that posed by 35 U. S. C. § 103. In terms of this case, on this issue, petitioner contends (and its affidavits affirm) that the new and useful Tatko pallet, as a realized whole, was not obvious at the time Tatko first devised it to any person having ordinary skill in the slate handling art. Unless the courts below decided this fact issue against petitioner, they had no basis in law to deny petitioner the right to patent conferred on it by Chapter 10 of Title 35, United States Code.

Thus the three judges of the Second Circuit who sat below reached a decision, in conflict with recent decisions of three other judges sitting there [*Lyon* v. *Bausch & Lomb Optical Co.*, 224 F. 2d 530 (2 Cir. 1955), *cert. den.* 350 U. S. 911 (1955)] and of three judges sitting in the District of Columbia [*L-O-F Glass Fibers Company* v. *Watson*, 228 F. 2d 40 (App. D. C. 1955)], which for reasons hereinafter fully set forth, this Court should review and correct.

Reason For Granting the Writ

There is doubt and confusion at both Bench and Bar as to the standard of "invention" applicable in patent cases today. This is an important matter of national consequence upon which this Court should now unequivocally rule.

This Court has not accepted for review any case rising under the Patent Act of 1952.* In fact the last opinions which this Court delivered upon the all important question of patentability were in its much discussed decision of *A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U. S. 147 (1950). It is not surprising that in this long interval of silence, the longest on this point in the post-Civil War history of this Court, divergent views have been expressed in the decisions of the lower Federal Courts** and in legal treatises*** about the requisites for patentability in the United States.

That the complete reenactment and revision of the patent laws of the United States into a systematized Title of the U. S. Code would inevitably give rise to some problems of interpretation is not surprising. This circumstance alone, as exemplified by Judge Frank's footnote 3 to his opinion in the present case (A. 3a), is a sufficient reason for this Court to grant the writ sought.

Petitioner also respectfully suggests that regardless of the effect of the Congressional action in revising and codifying the patent statutes, the last decisions of this Court on the question of patentability have proved to be themselves a source of doctrinal confusion.

We will consider here first the conflicts and confusions concerning the nature of patentability not involving the effect of the 1952 Act and then the further confusions which

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* Title 35 U. S. Code.

** For example, compare the decision of Judge Learned Hand in *Lyon* v. *Bausch & Lomb Optical Co.*, *supra*, with that of Judge Modarelli in *Avery* v. *Ever Ready Label Corp.*, 104 F. Supp. 913 (D. N. J. 1952).

*** For example, see Harris, *Some Aspects of the Underlying Legislative Intents of the Patent Act of 1952*, 23 Geo. Wash. L. Rev. 658 (1955).

that Act has given rise to, all of which taken together constitute an irresistible clamor for definitive action by this Court.

The Pandora's Box of the "Supermarket" Case.

By a *per curiam* decision in November of 1949, this Court apparently gave its stamp of approval to what was then the undoubtedly overwhelming weight of authority*, namely that the question of "invention" in a patent case is a question of fact. *Faulkner* v. *Gibbs*, 338 U. S. 267 (1949). This gave hard-pressed patentees and their counsel what appeared to be a firm and fair basis for hope that Mr. Justice Jackson's foreboding**, expressed a year earlier in his dissent in *Jungersen* v. *Ostby & Barton Co.*, 335 U. S. 560, 572 (1949), had been exaggerated. The apparent unanimity of *Faulkner* v. *Gibbs* and the rule which had there appeared so clear to the whole Court as to require only *per curiam* affirmance was brought into question by the *Supermarket* decision only a year later. In a special concurring opinion, joined in by Mr. Justice Black, Mr. Justice Douglas suggested that not only was the question of invention not a question of fact, but it transcended mere law to become a matter of Constitutional determination. The retreat from the jury "outpost" swept over trial judge and legislature alike right up to the bastion this Court alone controls.

Mr. Justice Jackson's majority opinion is something less than clear in its resolution of this problem. He said that the Court reached its conclusions "on the find-

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* *e. g. Thomson Co.* v. *Ford Motor Co.*, 265 U. S. 445, 446 (1924).

** ". . ., the only patent that is valid is one which this Court has not been able to get its hands on."

ings below" and lower on the same page that the Court sets "aside no finding of fact as to invention", but adds this cryptic qualification, "for none has been made except as to the extension of the counter, which cannot stand as a matter of law" (340 U. S. 153-4). One might interpret this qualification as a statement that the Court of Appeals below had erred in classifying its conclusion about the counter as a finding of fact and that determinations upon such matters should be termed conclusions of law were it not that the rest of the opinion very plainly seems to contemplate that findings of fact as to invention can still exist. It is respectfully submitted that it was the confusion thus engendered which led the District Court here to reach without trial a conclusion which it characterized itself "as to a large extent personal and in that sense arbitrary" (R. 94a). The uncertainty which this confusion has produced is well illustrated by comparing the litigation history of Packwood Patent Re. 23146* with that of Watson Patent 2,479,530.**

The importance of certainty as to whether "invention" is a constitutional, legal, or factual question is emphasized if, as in the present case, a motion for summary judgment has been made limited to the question of invention. The trial court must know whether that issue is one of law or fact in order to know whether it can properly be resolved by summary procedure. If the patentee insists, and makes a plausible showing of supporting circumstances to indicate, that his contribution was not at the time he made it

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* *Packwood* v. *Briggs & Stratton Corp.*, 99 F. Supp. 803 (D. Del. 1951), *rev'd* [for adhering to the "fact" rule] 195 F. 2d 971 (3 Cir. 1952), *cert. den.* 344 U. S. 844 (1952), *reh. den.* 344 U. S. 882 (1952).

** *Watson* v. *Heil*, 96 F. Supp. 61 (D. Md. 1951), *rev'd* [for *not* adhering to the "fact" rule] 192 F. 2d 982 (4 Cir. 1951), [patent held valid after application of "fact" rule] 97 U. S. P. Q. 334 (D. Md. 1952).

obvious to his co-workers, and, if the infringer insists, and makes a showing, that the contribution was an extremely simple one, is the trial court confronted with a fact issue upon which the parties have adduced conflicting evidence, thus requiring a trial, or is it confronted merely with a legal problem upon which the evidence by one side or the other can be dismissed as irrelevant and immaterial? The Court of Appeals for the Fourth Circuit reversed a holding of invalidity because the District Court had refused to consider proferred evidence of non-obviousness in *Watson* v. *Heil, supra.* The Court of Appeals for the Third Circuit overturned a jury verdict and thereby condemned as immaterial such evidence of non-obviousness in *Packwood* v. *Briggs & Stratton Corp., supra.* This conflict can only be resolved by this Court.

Enter the Patent Act of 1952.

During 1952, the Congress completely revised and codified the patent laws of the United States as Title 35 of the United States Code. The patent in this case was applied for, granted, litigated and held invalid under the provisions of this Act which had become effective January 1, 1953. Immediately upon promulgation the Act became the subject of controversy and conflict among the lower Federal courts especially upon the proposition: Did the new Act make any changes in the substantive patent law? The existence of this conflict is another facet of the reason now urged for the granting of the writ sought. The following not exhaustive list of cases is sufficient illustration of its existence: *Lyon* v. *Bausch & Lomb Optical Co., supra; L-O-F Glass Fibers Company* v. *Watson, supra; General Motors Corp.* v. *Estate Stove Co.*, 203 F. 2d 912 (6 Cir. 1953); *Vincent* v. *Suni-Citrus Products Co.*, 215 F. 2d 305, 315-6 (5 Cir. 1954); *Seismograph Service Corp.* v. *Offshore Raydist*, 135 F. Supp. 342, 350-1 (D. La. 1955); *Avery* v. *Ever Ready Label Corp., supra.*

The acuteness of the difficulty with this question has perhaps reached its ultimate in the present case. Judge

Frank, who presided over the Court of Appeals for the Second Circuit at the hearing of the appeal herein and wrote the opinion below, explained in that opinion (A. 3a) that he had serious doubts about the correctness of a ruling on the point by Judge Learned Hand sitting in the same Court about a year before.* Thus apparently it is not necessary to go outside the confines of the Second Circuit Court of Appeals itself to find not only a conflict with respect to the meaning of the Patent Act of 1952, but also a conflict so deep that the outcome of a patent case before it might predictably depend upon the make-up of the particular panel sitting. Surely this situation invites, and fairness to the lower courts compels, this Court to grant the writ here and rule definitively upon the question: Does 35 U. S. C. § 103 restore a historical and factual standard of invention or is it merely a codification of the pre-existing confusion?

CONCLUSION

For the foregoing reasons, this petition for a writ of certiorari should be granted.

Respectfully submitted,

W. Brown Morton, Jr.,
Attorney for Petitioner.

September 22, 1956.

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* *Lyon* v. *Bausch & Lomb Optical Co., supra.*

APPENDIX

Opinion and Judgment

of the

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

No. 313—October Term, 1955.

(Argued April 3, 1956 Decided May 8, 1956.)

Docket No. 23886

VERMONT STRUCTURAL SLATE COMPANY, INC.,
Plaintiff-Appellee,

—v.—

TATKO BROTHERS SLATE COMPANY, INC.,
Defendant-Appellant.

Before:

FRANK, MEDINA and WATERMAN,
Circuit Judges.

Appeal from a summary judgment, of the United States District Court for the Northern District of New York, entered by Judge Foley. Affirmed.

FRANK, *Circuit Judge*:

This is a suit for a declaratory judgment declaring defendant's patent invalid. The judge entered judgment for plaintiff, and defendant appeals. The facts are amply stated in the opinion of Judge Foley, reported in 134 F. Supp. 4. We agree with his conclusion.

Summary judgment represents a most useful legal invention to save time and expense, by the avoidance of a trial, when there exist no material fact-issues. It may well be that, in a patent case, a judge should exercise unusual caution in granting a summary judgment. But there are patent cases where it would be an absurd waste of time and effort to deny such a judgment. This is such a case.[1]

In many a patent suit, there arise issues of fact as to which the testimony of expert witnesses may be important. Then the credibility of those witnesses is crucial, and it would be erroneous, by a summary judgment, to deprive either party of a "live trial" at which the trial court could observe the witnesses' demeanor in evaluating their testimony.[2] There was no such issue here. The prior art and the patent claims are, without expert aid, easily understandable by anyone of the most modest intelligence. Nor did it require expert testimony to make it plain that the differences between the prior art and the patent claims were obvious to persons having ordinary skill in the trade at the time the alleged invention was made.

There was but one material issue of fact here, which defendant in the district court described as the "state of affairs existing in the industry at the time the (alleged) invention and the extent to which it has been adopted with resulting economies." On that issue, the trial judge fully accepted the statements in the affidavits filed by defendant as demonstrating (to quote the judge) "that this new arrangement of boards and stringers brought an advancement in utility, safety and economy in the industry." On that basis, he found as a fact: "It allows a more secure handling of the slate and stone when it is being lifted and

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[1] See, *e.g.*, *Park-In-Theatres* v. *Perkins*, 190 F. 2d 137, 142 (C. A. 9); 6 Moore, Federal Practice (2d ed. 1953) Section 56.17 (44).

[2] *Bridgeport Brass Company* v. *Bostwick Laboratories*, 181 F. 2d 315 (C. A. 2).

transported. It may be that less labor is needed in such efforts and the vertical filing permits stocking of the slabs as to color on the pallets which is desirable to purchasers. All these endorsements are set forth in the answering affidavits * * * and I accept them fully as to the usefulness of the Tatko pallet * * * This attribute of utility is further advanced by the adoption of a most similar pallet by plaintiff * * *" It follows that the credibility of witnesses on this issue of fact was not involved. The judge therefore correctly rejected the contention made by defendant in the court below that, on this issue, the judge "should await the presentation of testimony." If the question of patentable invention were a "close one," the facts here thus taken as true might tip "the scales of judgment" in defendant's favor; but where "invention is plainly lacking," such a fact "cannot fill the void." *Jungersen* v. *Ostby & Barton Co.*, 335 U. S. 560, 567. We agree with the judge that here the question of invention was not at all close. The patent disclosed no more ingenuity than that of a man skilled in the art.

Plaintiff argues that the recent amendment to the patent statute, 35 U. S. C. Section 103, lowered the standard of invention, citing *Lyon* v. *Bausch & Lomb Optical Co.*, 224 F. 2d 530, 535-536 (C. A. 2).[3] Even so, the plaintiff's patent, we think, is clearly sub-standard.[4]

Affirmed.

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[3] The writer of this opinion has serious doubts about the correctness of that ruling. See the following to the effect that the amendment merely codified the existing decisions: *Stanley Works* v. *Rockwell Mfg. Co.*, 203 F. 2d 846 (C. A. 3); *General Motors Corp.* v. *Estate Stove Co.*, 203 F. 2d 912 (C. A. 6); *Interstate Rubber Products Corp.* v. *Radiator Specialty Co.*, 214 F. 2d 546 (C. A. 4); *Wasserman* v. *Burgess & Blacher Co.*, 217 F. 2d 402 (C. A. 1).

[4] *See Gentzel and Foster Engineering Co.* v. *Manning, Maxwell & Moore, Inc.*, F. 2d (C. A. 2, March 1, 1956).

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W. BROWN MORTON, JR.,
247 Park Avenue,
New York 17, N. Y.,
Attorney for Petitioner.

ACKERMAN PRESS, Phones BO 9-7107-8

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This Supplement is filed because on September 24, 1956, the same day that the original Petition was filed herein, a decision was rendered in a companion case directly in conflict with the decision sought to be reviewed.

The New Opinions Below

The opinions, judgments and orders rendered September 24, 1956 by the United States District Court for the District of Vermont in the companion case entitled "*Tatko Brothers Slate Co., Inc.* v. *Matthew Hannon,* Civil Action No. 1836" are printed in the Supplemental Appendix hereto (SA 1a-4a) and are not yet reported. A certified copy of these opinions, judgments, and orders has been filed herewith.

Supplemental Statement of the Case

For convenience, the District Court proceedings directly below will be referred to as "the *Albany* case" and the District Court proceedings in the newly decided companion suit, as "the *Vermont* case".

The counterclaim in the *Albany* case pleaded in part:

> "27. The invention of said patent provides a practical pallet for use in handling slate products safely and the pallet construction devised by said John Tatko has been in extensive commercial use by defendant and has fulfilled a long felt want in the trade of defendant and its customers, which enables the pallet to be efficient and economically loaded with slate products at the quarry and lifted by a fork truck onto a trailer truck or railway car for economic transport to the desired point of destination. This is made possible by reason of the provision of pockets or slots at the ends of the pallet, constructed to receive end gates or walls, or flat slabs of slate in upstanding relation therein to form end supports for the pallet to confine and wedge there between slabs of slate that are arranged in upstanding side-by-side relation on the pallet as a rigid unit thereon and to prevent the said unit from falling apart and individual slabs becoming lost in transportation." (R. 17a-18a)

Among the numerous uncontradicted affidavits submitted in the *Albany* case, one by the inventor Tatko asserted *inter alia* (R. 51a-52a):

> "4. That the conventional pallets described in paragraph '3' above, although in general use before his invention of the patented pallet, had many disadvantages and hazards connected with their use, particularly by reason of the necessity to arrange the slabs of slate or stone horizontally thereon in vertically extending piles so that, during the lifting or trans-

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portation of a loaded pallet the slabs of slate or stone were free to shift horizontally and fall from the pallet with great possible injury to workmen handling the loaded pallets or to property or persons along public roads;".

Another such affidavit, by one Wolcott, an up-state New York slate distributor, stated *inter alia* (R. 58a):

"7. That because of the provision of the slots or pockets at the ends of the Tatko patented pallet, some of the slabs or pieces of slate or stone being transported may be inserted in the pockets in upstanding relation and used as end supports or walls to support and wedge the other slabs or pieces of stone in upstanding relation on the pallet, eliminating edgewise displacement which would cause the slabs to fall apart and become lost in transportation. The Tatko patent provides a practical pallet for use in handling slate safely and fulfills a long-felt want in the trade which enables the pallet to be safely filled with slate at the quarry and safely lifted by a fork truck into a trailer truck and safely transported to the desired destination;".

The *Vermont* case was an action for patent infringement brought directly by petitioner against one of its competitors located in Vermont, a Mr. Matthew Hannon. Hannon was represented before Judge Gibson by the same counsel that appeared for respondent in the *Albany* case. After the decision in the *Albany* case, a motion for summary judgment of dismissal of the *Vermont* case on the grounds of lack of invention was made on Hannon's behalf. It was this motion which Judge Gibson *denied* the same day that the present petition was filed. In opposition to the motion in the *Vermont* case, nine affidavits were filed on Tatko Company's behalf. Only one of the affiants, Wolcott, had had an affidavit before the court in the *Albany* case. The affidavits in the *Vermont* case went beyond the affidavits in the *Albany* case in elaborating

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prior attempts of the slate industry to "palletize" its products and included as affiants persons long engaged in the pallet and fork lift truck business who attested to such prior unsuccessful efforts. Undoubtedly the Vermont affidavits presented overwhelmingly better *proof* of the existence of long felt want and prior unsuccessful efforts to achieve it than did the affidavits in the *Albany* case. However, in view of the pleadings in the *Albany* case and the passages quoted, it cannot be said that the *issue* of whether such a historical situation had existed was not squarely presented to Judge Foley in Albany and to the Court of Appeals below.

It is noteworthy that Judge Gibson left his courtroom to have a "view" of the patented pallets in actual operation (SA 2a).

Reason for Granting the Writ Reiterated

There is doubt and confusion at both Bench and Bar as to the standard of "invention" applicable in patent cases today. This is an important matter of national consequence upon which this Court should now unequivocally rule.

The heart of Judge Gibson's opinion appears in its final sentence (SA 3a):

> "Accepting the affidavits as true, it follows that a genuine issue of a material fact is present in this case. If the industry, over a period of years, tried to solve this problem and met with failure, then the introduction of the Tatko pallet presents a real live issue—namely, 'Is the utilization of flagstone to confine the stacked flagstone on the upper tier of the pallet by the use of end pockets an innovation that was "obvious to a person having ordinary skill in the art."' "

It is impossible to reconcile this view with the following paragraph quoted from the opinion of the Court of Appeals below (A 2a):

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"In many a patent suit, there arise issues of fact as to which the testimony of expert witnesses may be important. Then the credibility of those witnesses is crucial, and it would be erroneous, by a summary judgment, to deprive either party of a 'live trial' at which the trial court could observe the witnesses' demeanor in evaluating their testimony. There was no such issue here. The prior art and the patent claims are, without expert aid, easily understandable by anyone of the most modest intelligence. Nor did it require expert testimony to make it plain that the differences between the prior art and the patent claims were obvious to persons having ordinary skill in the trade at the time the alleged invention was made."

While it is certainly true that the affidavits presented to Judge Gibson were more convincing and better calculated to persuade the court of the *fact* of the non-obviousness of the Tatko invention than the affidavits presented in the *Albany* case, both Judge Foley in that *Albany* case and Judge Frank in his opinion affirming Judge Foley take the position that such is the nature of the claimed Tatko innovation that, as a matter of *law, no* evidence could show that it involved "invention". Accordingly there is here presented a square conflict between decisions of federal courts below as to what is the nature of the question of invention in a patent case, and as to what evidence, if any, is required to resolve it.

CONCLUSION

The foregoing showing, supplementing the suffiicent reasons of the original Petition, affords a necessary reason that this petition for a writ of certiorari should be granted.

Respectfully submitted,

W. Brown Morton, Jr.,
Attorney for Petitioner.

September 22, 1956.

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APPENDIX

Opinions, Judgments, and Orders

of the

UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF VERMONT

CIVIL ACTION No. 1836

TATKO BROTHERS SLATE CO., INC.,

v.

MATTHEW HANNON

Statement of the Case, Conclusions of Law and Judgment Order

Statement of the Case

The plaintiff instituted this action for infringement of its patent, Patent No. 2,693,926. The subject matter of this patent is a double platformed wooden pallet used for stacking and transporting flat stone pieces in a stacked vertical relationship on a platform for use with a fork-lift truck. Stones are stacked in pockets at the ends of the pallet to confirne [*sic*] the slate stacked vertically on the upper tier of the pallet between the upstanding slabs in the pockets.

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Appendix

The defendant filed a motion for summary judgment under Rule 56, F. R. C. P., in which it contends that there is no genuine issue as to any material fact as required by Rule 56(c). In support of its motion, the defendant relies upon the *Vermont Structural Slate Co., Inc.* v. *Tatko Brothers Slate Co., Inc.* decision, reported in 134 F. Supp. 4 and affirmed by the 2 C. C. A. in 233 F. 2d 9. In that case, Vermont Structural Slate Co., Inc. brought a petition for a declaratory judgment in the U. S. District Court for the Northern District of New York, in which it sought to have declared invalid Patent No. 2,693,926, the patent here in suit. The District Court granted a summary judgment on the grounds that the patent expresses no patentable invention over prior art. The affidavits filed in that case did not touch upon the fact that the industry had tried to solve the handling and transporting of slate problem without success for many years. See affidavit of Maxwell Sparrow, of counsel for Tatko Brothers in the former case. The decision of the District Court was affirmed by the 2 C. C. A. on the ground that invention was plainly lacking and disclosed no more ingenuity than that of a man shilled [*sic*] in the art. See 233 F. 2d at 11.

The plaintiff, in answer to the defendant's motion for summary judgment, filed affidavits of nine persons in support of its contention that there is a genuine issue of a material fact in this case.

The above-entitled cause came on for hearing at Brattleboro on July 16, 1956. Arguments were made, briefs filed, and exhibits were received by this Court at the hearing. Upon plaintiff's motion made at the hearing, this Court, along with counsel for plaintiff and defendant, observed the transporting of slate stacked vertically upon the Tatko pallet with the use of a fork-lift truck at the Woodward Lumber Mill in Brattleboro, Vermont, and ob-

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served and compared the Tatko pallet with the Cruickshank pallet, No. 2,297,347, and the Lilienfeld pallet, Patent No. 2,471,693.

Conclusions of Law

The decision of the *Vermont Structural Slate Co., Inc.* v. *Tatko Brothers Slate Co., Inc., supra,* is not *res adjudicata* of the issues herein because the parties to this action are not the same, nor are they in privity with the parties in the former action. *Triplett et al.* v. *Lowell et al.,* 297 U. S. 638, 642-644; *Gold Seal Importers, Inc.* v. *Westerman-Rosenberg, Inc.,* 133 F. 2d 192.

The issue for this Court's determination is whether a genuine issue of a material fact is presented in the affidavits filed by the plaintiff. Rule 56(c) F. R. C. P. The affidavits in this case disclose the utility, safety, economy, and commercial success of the Tatko pallet. Similar affidavits were filed in the former case. In this case, however, the affidaivts also tend to show that the industry had tried to solve the problem of handling and transporting flagstone over a long period of time, all without success. See affidavit of Richard Slade, page 3.

Accepting the affidavits as true, it follows that a genuine issue of a material fact is present in this case. If the industry, over a period of years, tried to solve this problem and met with failure, then the introduction of the Tatko pallet presents a real live issue—namely, "Is the utilization of flagstone to confine the stacked flagstone on the upper tier of the pallet by the use of end pockets an innovation that was 'obvious to a person having ordinary skill in the act [*sic*].'" *Welsh Manufacturing Company* v. *Sunware Products Co.,* 2 C. C. A., decided July 9, 1956,—— F. 2d——; *Lyon* v. *Bausch & Lomb Optical Co.,* 224 F. 2d 530.

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Appendix

Judgment Order.

Inasmuch as the affidavits filed herein present a genuine issue as to a material fact, the defendant's motion for summary judgment is hereby denied.

ERNEST W. GIBSON,
Ernest W. Gibson,
U. S. District Judge.

Dated: Brattleboro, Vermont, September 24, 1956.

Endorsed: Filed September 24, 1956,
AUSTIN H. KERIN, Clerk.

Order Denying Defendant's Motion for Attorneys' Fees

In the above-entitled cause the defendant filed a motion for attorneys' fees under Section 285 of Title 35, U. S. C. Both parties have submitted briefs in this matter.

Section 285 of Title 35, U. S. C. provides as follows:

> "The court in exceptional cases may award reasonable attorneys' fees to the prevailing party."

Inasmuch as there is no basis in this case for a finding of bad faith on the part of the plaintiff, nor is there any basis for a finding that the plaintiff is pursuing non-justiciable litigation in this matter, the defendant's motion for attorneys' fees is hereby denied. See *Keuffel & Esser Co.* v. *Masback, Inc.*, 131 F. Supp. 237, citing *Park-In-Theatres, Inc.* v. *Perkins*, 190 F. 2d 137.

ERNEST W. GIBSON,
Ernest W. Gibson,
U. S. District Judge.

Dated: Brattleboro, Vermont, September 24, 1956.

Endorsed: Filed September 24, 1956,
AUSTIN H. KERIN, Clerk.

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Office - Supreme Court, U.S.
FILED
OCT 24 1956
JOHN T. FEY, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1956

No. 444

TATKO BROTHERS SLATE CO., INC.,
Petitioner,

v.

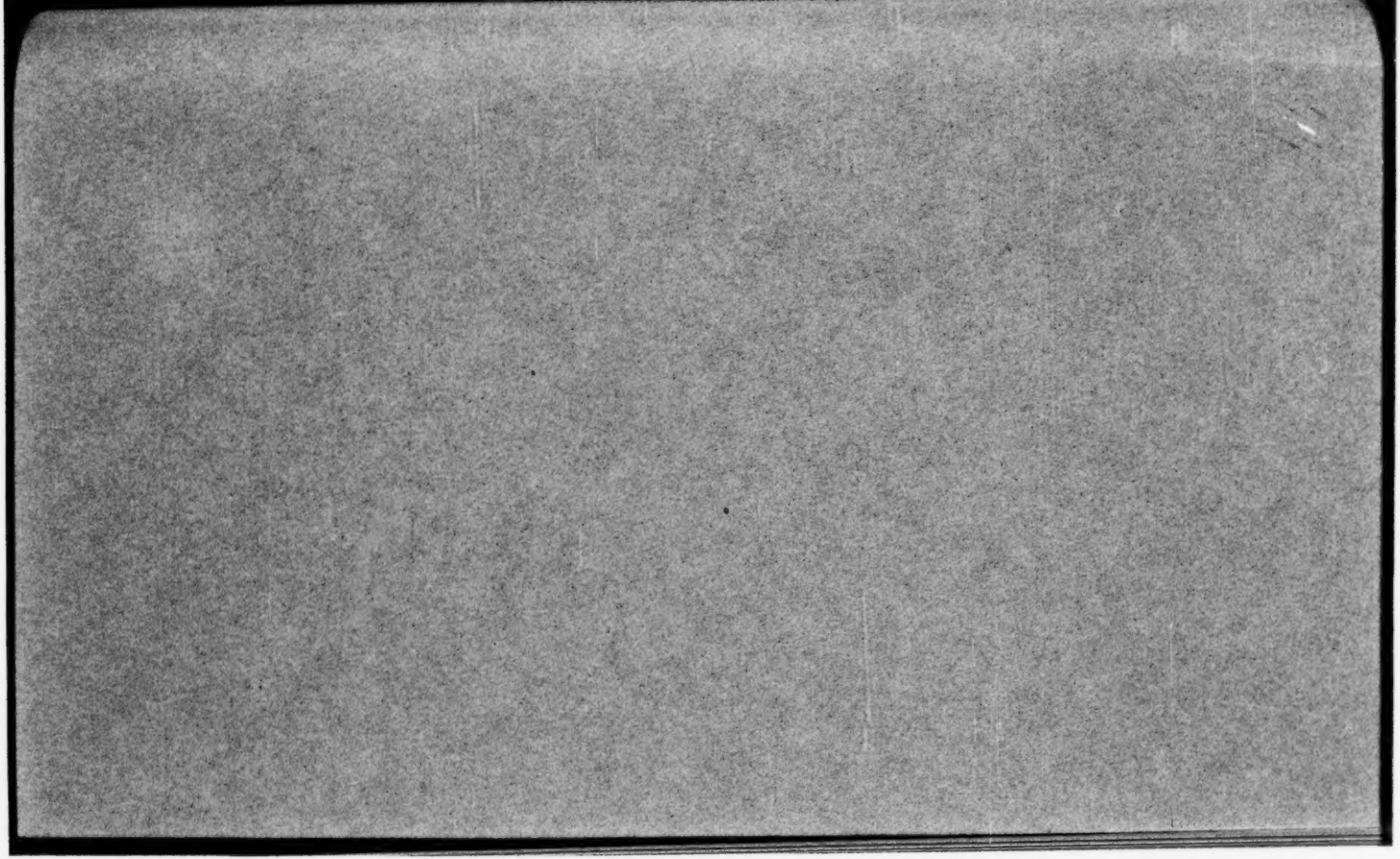
VERMONT STRUCTURAL SLATE CO., INC.,
Respondent.

RESPONDENT'S MEMORANDUM IN OPPOSITION TO A PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

RICHARD P. SCHULER
425 13th Street, N. W.
Washington, D. C.
Attorney for Respondent

Of Counsel:

BLAIR AND SPENCER
JOHN C. BLAIR
Stamford, Conn.



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IN THE

Supreme Court of the United States

OCTOBER TERM, 1956

No. 444

TATKO BROTHERS SLATE CO., INC.,
Petitioner,

v.

VERMONT STRUCTURAL SLATE CO., INC.,
Respondent.

RESPONDENT'S MEMORANDUM IN OPPOSITION TO A PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

Respondent, Vermont Structural Slate Co., Inc., opposes the petition for a writ of certiorari on the following grounds:—

1. There is nothing in the opinion of the Court of Appeals below requiring or justifying a review of this case by the Supreme Court.

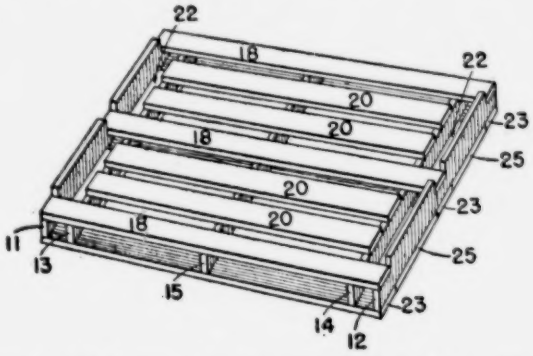
2. Petitioner's conclusion that Section 103* and case interpretations thereof have created confusion as to standards of patentability is unsound.

3. The Court of Appeals did not err in holding the Tatko patent invalid without trial.

* 35 U. S. C. § 103.

STATEMENT OF THE CASE

The petition, like the drawings and specification of the Tatko patent in suit (R. 35a-37a), fosters an atmosphere of complexity when, in fact, the construction involved is the utmost in simplicity. The patent discloses a pallet for use with a fork lift truck such as have been in extensive use long prior to the alleged invention. A glance at a clear showing of the Tatko pallet and a few words of explanation are all that is necessary to a complete understanding thereof.



Boards 23 form the bottom and boards 18 and 20 its top. Stringers 11, 12, 13, 14 and 15 are interposed therebetween. Boards 20 are shorter than boards 18 to form pockets 22 for insertion of stone end pieces which hold stacked flagstones thereon. Fork lift trucks may thus lift and transport these loaded pallets.

The three Tatko claims despite their "magical setting of words"* define no more than the structure disclosed, to wit, a pair of spaced horizontal platforms with traversing stringers therebetween, some of the top boards being shorter to provide pockets in the ends of the pallets for insertion of stone end pieces.

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* District Court, opinion below. (R. 92a).

In the final analysis, the Tatko innovation amounts to the suggestion that slots be provided at the ends of a well-known standard pallet (R. 38a) for the reception of stone end pieces which act in a known manner to hold the remaining stones on the pallet (R. 45a).

Petitioner's erroneous interpretations of the holdings below and its asserted "conflict" in the Second Circuit are discussed hereinafter (*infra* P. 7).

ARGUMENT

THERE IS NOTHING IN THE OPINION OF THE COURT OF APPEALS BELOW REQUIRING REVIEW BY THE SUPREME COURT

Petitioner contends that the District Court "did not understand the nature of 'invention' as a requirement for patentability" and that the Court of Appeals erred in "perpetuating the same error of law" (Petition, P. 6). The fact is that the Court of Appeals, when ruling on validity followed precisely the standards of patentability recognized and followed by this Court for more than a century.* These long recognized standards were finally codified in Section 103 of the Patent Act

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* *Atlantic Works* v. *Brady*, 107 U. S. 192 (1882); *Slawson* v. *Grand Street R. R. Co.*, 107 U. S. 649 (1882); *Phillips et al.* v. *Detroit*, 111 U. S. 604 (1884); *Pomace Holder Company* v. *Ferguson*, 119 U. S. 335 (1886); *Hendy* v. *Miners' Iron Works*, 127 U. S. 370 (1888); *Hollister* v. *Benedict Manufacturing Co.*, 113 U. S. 59 (1885); *Duer* v. *Corbin Cabinet Lock Co.*, 149 U. S. 216 (1893); *Olin* v. *Timken*, 155 U. S. 141 (1894); *Market Street Railway Co.* v. *Rowley*, 155 U. S. 621 (1895); *Werk* v. *Parker*, 249 U. S. 130 (1919); *Concrete Appliances Co.* v. *Gomery*, 269 U. S. 177 (1925).

of 1952 (Title 35 United States Code). The Court of Appeals below stated:

> "The prior art and the patent claims are, without expert aid, easily understandable by anyone of the most modest intelligence. Nor did it require expert testimony to make it plain that the differences between the prior art and the patent claims were obvious to persons having ordinary skill in the trade at the time the alleged invention was made."*

It has long been established law that Courts may take judicial notice of obvious facts in the prior art, and, where as here, the claimed invention is easy to comprehend a court may apply accepted legal standards of patentability thereto**; such circumstance obviates the necessity for a trial. To hold otherwise would make a mockery of summary judgment proceedings in patent cases; to defeat such a motion the patent proponent would merely be required to file affidavits claiming utility for the invention. Such a result was never intended in a case such as this. As well stated by the Court of Appeals:

> "Summary judgment represents a most useful legal invention to save time and expense, by the avoidance of a trial, when there exist no material fact-issues. It may well be that, in a patent case, a judge should exercise unusual caution in granting a summary judgment. But there are patent cases where it would be an *absurd waste of time* and effort to deny such a judgment. *This is such a case.*"***

---

* Petition's Appendix, P. 2a.

** *Brown v. Piper,* 91 U. S. 37 (1875); *Slawson* v. *Grand Street R. R. Co.,* 107 U. S. 649 (1882); *Black Diamond Co.* v. *Excelsior Co.,* 156 U. S. 611 (1895); *Richards* v. *Chase Elevator Co.,* 158 U. S. 299 (1895); *Specialty Mfg. Co.* v. *Fenton Mfg. Co.,* 174 U. S. 492 (1899); *Concrete Appliances Co.* v. *Gomery,* 269 U. S. 177 (1925).

*** Petition's Appendix P. 2a—emphasis added.

Having found no genuine issue as to any material fact, the Court of Appeals was free to hold as a matter of law:

> "The patent disclosed no more ingenuity than that of a man skilled in the art."*

PETITIONER'S CONCLUSION THAT SECTION 103 OF THE UNITED STATES CODE AND CASE INTERPRETATIONS THEREOF HAVE CREATED CONFUSION AS TO STANDARDS OF PATENTABILITY IS UNSOUND

Petitioner's asserted "conflict", "doubt" and "confusion"** over interpretation of Section 103 relating to standards of patentability is imaginary and at best wishful thinking. Indeed, this law has remained unchanged since *Hotchkiss* v. *Greenwood,* 11 How. (52 U. S.) 248 (1850), enunciated the principle. As stated by this Court in *Dunbar* v. *Meyers,* 94 U. S. 187,197 (1876),

> "Invention or discovery is the requirement which constitutes the foundation of the right to obtain a patent; and it was decided by this court, more than a quarter of a century ago, that unless more ingenuity and skill were required in making or applying the said improvement than are possessed by an ordinary mechanic acquainted with the business, there is an absence of that degree of skill and ingenuity which constitute the essential elements of every invention."

Section 103 is a plain and accurate codification of this law. It says that a "patent may not be obtained" on anything which differs from the prior art in a man-

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* Petition's Appendix P. 3a.

** Petition P. 7.

ner which "would have been obvious . . . to a person having ordinary skill in the art to which the subject matter pertains." Since the enactment of Section 103, Courts have consistently held that it made no change in this settled test of patentability.*

The petition attempts to capitalize on the footnote in Judge Frank's opinion wherein he expresses "serious doubts" about Judge Learned Hand's ruling in *Lyon* v. *Bausch & Lomb Optical Co.*, 224 F. 2d 530 (C. A. 2, 1955). Whether any significant divergence in viewpoint exists in the Court of Appeals is to be doubted. But assuming such to be the case it is immaterial here for it is not such a "special and important" reason** as would justify review by this Court.

At the very most, Judge Hand merely held that Section 103 restored the standards of patentability which existed roughly 25 years before the Patent Act of 1952.***

And that law referred to as established for 70 or 80 years is the very law relied upon by the Court of Appeals in invalidating the Tatko patent.† Indeed,

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* *Wasserman* v. *Burgess & Blacher Co.*, 217 F. 2d 402 (C. A. 1, 1954); *Interstate Rubber Prod. Corp.* v. *Radiator Specialty Co.*, 214 F. 2d 546 (C. A. 4, 1954); *Vincent* v. *Suni-Citrus Products Co.*, 215 F. 2d 305 (C. A. 5, 1954); *Stanley Works* v. *Rockwell Mfg. Co.*, 203 F. 2d 846 (C. A. 3, 1953); *General Motors Corp.* v. *Estate Stove Co.*, 203 F. 2d 912 (C. A. 6, 1953); Application of *O'Keefe*, 202 F. 2d 767 C. C. P. A. (1953); *Pacific Contact Laboratories* v. *Solex Laboratories*, 209 F. 2d 529 (C. A. 9, 1953).

** Rule 19 of the Rules of the Supreme Court of the U. S.

*** "In the first place § 103 only restores the original gloss, substantially in ipsissimis verbis; which has never been overruled; but on the contrary for 70 or 80 years had continued to be regarded as authoritative." 224 F. 2d 530, 536.

† "Plaintiff argues that the recent amendment to the patent statute, 35 U. S. C. Section 103, lowered the standard of invention, citing *Lyon* v. *Bausch & Lomb Optical Co.*, 224 F. 2d 530, 535-536 (C. A. 2). Even so, the plaintiff's patent, we think, is clearly sub-standard." Petition's Appendix P. 3a.

Section 103 does not depart one iota from that principle so well stated in 1876 by this Court in *Dunbar* v. *Meyers, supra.*

* * * * *

The supplemental petition asserts that the District Court's decision in *Tatko Brothers Slate Co., Inc.* v. *Matthew Hannon** is "directly in conflict" with the decision of the Court of Appeals here sought to be reviewed.

Petitioner's present assertions are in direct conflict with counsel's argument before Judge Gibson which was successful in persuading the Court that there was an issue before it *which had not been before the Court of Appeals.* A reading of Judge Gibson's opinion leaves no doubt that this was his understanding,

> " The affidavits in *this* case disclose the utility, safety, economy, and commercial success of the Tatko pallet. Similar affidavits were filed in the former case. In *this* case, *however,* the affidavits *also* tend to show that the industry had tried to solve the problem of handling and transporting flagstone over a long period of time, all without success."**

Thus, Judge Gibson held "that a genuine issue of a material fact is present in *this case.*" (Tatko Brothers v. Hannon in Vermont). Therefore, for that reason alone, the Vermont Court denied the defendant's motion for summary judgment.

---

* ....F. Sup. ....., (D. C. Vt. 1956), Supplement to Petition's Appendix, P. 1a.

** Supplement to Petition's Appendix P. 3a, emphasis added.

THE COURT OF APPEALS DID NOT ERR IN HOLDING THE TATKO PATENT INVALID WITHOUT TRIAL

The petition confuses the issue by using the term "invention" to designate two things, to wit, (1) the subject matter sought to be patented (here the construction of the Tatko pallet) and (2) the question of patentability (here whether such pallet is patentable).* By so doing it concludes erroneously that patentability cannot be determined "as a matter of law by judicial comparison of the thing invented with the things of the prior art" but only "as a matter of fact by weighing the available evidence." This is precisely contrary to established law. The question whether certain subject matter is patentable has always been one of law.**

A condition precedent to such determination is an understanding of the subject matter sought to be patented. Here, the Court of Appeals first found that " The prior art and the patent claims are, without expert aid, easily understandable by anyone of the most modest intelligence." It then ruled as a matter of law that the patent is invalid.

In *Packwood* v. *Briggs & Stratton Corp.*, 195 F. 2d 971 (C.A. 3, 1952) cited in the petition*** the Court correctly held that once the subject matter had been established by evidence, patentability had to be measured as a matter of law against established legal standards. *Watson* v. *Heil,* 192 F. 2d 982 (C.A. 4,

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* Petition, Pp. 6-7, 10.

** *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147, 155; *Mahn* v. *Harwood,* 112 U. S. 354, 358 (1884).

*** Petition, P. 10.

1951), is not in conflict with this ruling, for it merely held that evidence of the state of the art might tip the scales in favor of patentability and hence such evidence should have been considered by the trial court. In the present case the Court of Appeals held that because the question *was not at all close* such evidence could not possibly affect the ultimate result.†

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be denied.

Respectfully submitted,

RICHARD P. SCHULZE
Attorney for Respondent

Of Counsel:

BLAIR AND SPENCER
JOHN C. BLAIR
Stamford, Conn.

October 22, 1956

† Petition's Appendix P. 3A.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1956

No. 444

TATKO BROTHERS SLATE CO., INC.,
Petitioner,

v.

VERMONT STRUCTURAL SLATE CO., INC.,
Respondent.

PETITIONER'S REPLY BRIEF

W. BROWN MORTON, JR.,
247 Park Avenue,
New York 17, N. Y.,
Attorney for Petitioner.

ACKERMAN PRESS, Phones BO 9-7107-8

IN THE

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TATKO BROTHERS SLATE CO., INC.,

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Respondent.

PETITIONER'S REPLY BRIEF

Respondent takes the position (Brief in Opposition, p. 3) that the standards governing patentability have been clearly defined for more than a century and that these long recognized standards were finally codified in Section 103 in the Patent Act of 1952 (35 U. S. C. § 103). The error of this is pointed up by Judge Kalodner in the recently decided case of *R. M. Palmer Company* v. *Luden's, Inc.*, 236 F. 2d 496 (3 Cir. 1956) where it is stated:

> "The provisions of Section 103, 35 U. S. C., 1952 ed., as set forth in footnote 3, are new. The purpose of the provisions as stated by the Reviser is to achieve a stabilizing effect, and to render immaterial whether the invention resulted from 'flash of genius'.
>
> "* * * To what extent a change is wrought would seem to depend upon the preexisting views of a tribunal as to the standard which it has determined patentability * * *" (p. 499).

Respondent takes the position that petitioner's asserted "confusion" over interpretation of Section 103 relating to standards of patentability is imaginary and at best wishful thinking. The error of this position and the existing confusion is demonstrated by *Blish Hardware Co.* v. *Time Saver Tools, Inc.*, —— F. 2d ——, 111 USPQ 6 (10 Cir. 1956) wherein the Court said:

> "* * * It is agreed that the statutory standards for invention are but the codification of the common law—some courts say, as it has existed for the past one hundred years without recognition of any change in the inventive concept. Interstate Rubber Products Corp. v. Radiator Specialty Co., Inc., 214 F. 2d 546, 102 USPQ 224. Others say, as it existed at the time of codification. Bobertz v. General Motors Corp., 228 F. 2d 94, 107 USPQ 338; General Motors Corp. v. Estate Stove Co., 203 F. 2d 912, 97 USPQ 88; Wasserman v. Burgess & Blacher Co., 217 F. 2d 402, 103 USPQ 368; Seismograph Serv. Corp. v. Offshore Raydist, Inc., 135 F. Supp. 342, 107 USPQ 104; Burt v. Bilofsky, 120 F. Supp. 822, 101 USPQ 169. Still another court says that the underlying legislative intent was to ameliorate the harshness of the inventive concept inherent in the authoritative cases of the past two decades. Lyon v. Bausch & Lomb Optical Co., 224 F. 2d 530, 106 USPQ 1, cert. denied 350 U. S. 911, 107 USPQ 362 * * *" (p. 7).

Respondent attempts to factually distinguish the District Court's decision in the *Vermont* case (*Tatko Brothers Slate Co., Inc.* v. *Matthew Hannon*, —— F. Supp. —— (D. Vt. 1956) from the decision of the court below. It seems obvious that the conflict is in judicial thinking rather than in the facts before those courts.

Respondent states "The question whether certain subject matter is patentable has always been one of law"

(Brief in Opposition, p. 8). The factual nature of the question of patentability and the necessity of evidence to meet the test was recognized by the court below in *Welsh Manufacturing Co.* v. *Sunware Products Co.,* 236 F. 2d 225 (2 Cir. 1956) decided after the decision in the case at bar. There Judge Lumbard stated:

> "[4] We think it clear that even under the relaxed standard of invention of Lyon v. Bausch & Lomb Optical Co., 2 Cir., 1955, 224 F. 2d 530, there was no invention here. It is not enough to show that the patentee's device was new and useful. It must in addition be an innovation which was not 'obvious * * * to a person having ordinary skill in the art.' In the Bausch & Lomb case we found that 'the most competent workers in the field had for at least ten years been seeking a hardy, tenacious coating to prevent reflection; there had been a number of attempts, none satisfactory; * * * when it appeared, it supplanted the existing practice and occupied substantially the whole field.' 224 F. 2d at page 535. Here there is no evidence that there had been any sustained effort over a period of time to find a way of combining the top bar and sweat bar of sun glasses. Nor was it shown that there was a great demand in the industry for such a combination * * *" (p. 227).

Thus, the Court recognizes the necessity of evidence to establish the existing conditions within an industry at the time an invention was made in order to determine whether that invention was "obvious" to a man skilled in the art at that time. This recognition of the importance of such evidence in meeting the issue of patentability makes the decision of the court below in the *Welsh Manufacturing Co.* case, *supra,* in conflict with the decision of the court below in the case at bar where the Court summarily invalidated petitioner's patent and denied it the right to offer evidence of invention.

The existing confusion in judicial thinking regarding the statutory test of patentability demonstrates the need for a definitive ruling by this Court on that subject.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be granted.

Respectfully submitted,

W. Brown Morton Jr.,
Attorney for Petitioner.

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